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10/509,461

09/28/2004

Ronald Joseph Antonius Van Den Oetelaar

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EXAMINER

HEYI, HENOK G

ART UNIT

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2627

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,461

Applicant(s)

VAN DEN OETELAAR ET AL.

Examiner

Henok G. Heyi

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Argument

Applicant's argument against the nonstatutory double patenting rejection is not based on the cited claims in the cited reference 023'; instead applicant refers to the specification of the 023' reference. In double patenting rejection, the conflicting claims in the application are compared with claims in potential double patent reference. As it is previously pointed out the claims in the current application are notably similar to the claims in the 023' reference with little to nothing difference. Hence, the double patenting rejection is reaffirmed.

Specification

1. Claims 6 and 7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 5. See MPEP § 608.01(n). Accordingly, the claims 6 and 7 not been further treated on the merits.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2, 3, 4, 5 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 8 of U.S. Patent No. 20050163023 respectively in view of Miyamoto et al. US 2001/0016242 A1 (Miyamoto hereinafter).

With reference to the table below:

Re claim 1, the only difference between the two claims in the table and claim 1 is that claim 2 specifies about the thickness of the transparent spacer layer in detail. Other than that, both sides of the table show an optical data storage medium with dual layers and a transparent spacer layer in between.

Re claim 2, again we don't see that much of a difference in the way these two claims are claimed except the fact that one of the claims gives a choice of selecting different kinds of layers while the other is limited to only a rewritable layer.

Re claim 3, both claims are drawn to the entrance face of the protective resinous layer.

One of the claims goes further to claim other layers while the claim in the current application limits the claim to the entrance face.

Re claim 4, what is claimed in this application is very similar to what has been claimed in the previous application except the fact that in the earlier application the claim is drawn more specifically about the thickness of the transparent spacer layer.

Re claim 5, both claims claim that the second radiation beam entrance face is in the first substrate.

Re claim 6, both claims are similar and both claim that the second radiation beam entrance is found in the second protective plastic/resinous cover layer.

| Present Application 10/509,461 | <i>US 20050163023</i> Van Den oetelaar |
|---|---|
| 1. A dual stack optical data storage medium for recording and reading by means of a focused radiation beam entering the medium through a first radiation beam entrance face, said medium having at least a first substrate with on at least one side of the first substrate: a first layer stack, comprising a first information layer, a second layer stack, comprising a second information layer, said first layer stack being present at a position closer to the first radiation beam entrance face than the second layer stack, a first transparent | 1. An optical data storage medium (20) for recording by means of a focused radiation beam (9) entering the medium through a first plastic/resinous layer (1) which is transparent for the radiation beam (9), said medium further comprising at least: a first recording stack (2), comprising a first recording layer, being present proximate the first plastic/resinous layer, a second recording stack (4), comprising a second recording layer, said second recording stack (4) being present at a position more remote from the first plastic/resinous layer (1) than the first |

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| <p>spacer layer between the first layer stack and the second layer stack, characterized in that the first information layer is one selected from the group of types consisting of a read only layer and a write once layer, and that the second information layer is one selected from the group of types consisting of a read only layer, a write once layer and a rewritable layer, and that the type of the first information layer is different from the type of the second information layer.</p> | <p>recording stack (2), a transparent spacer layer (3) between the first and the second recording stack having a thickness larger than the depth of focus of the focused radiation beam characterized in that a first optically transparent thermal barrier layer (b1) interposed between the first recording stack and the first plastic/resinous layer.</p> <p>2. An optical data storage medium (20) as claimed in claim1, wherein the first recording layer is a write once layer and the second recording layer is one selected from a write once layer, a rewritable layer and a read only layer.</p> |
| <p>2. A dual stack optical data storage medium as claimed in claim 1, wherein the second information layer is a rewritable layer.</p> | <p>2. An optical data storage medium (20) as claimed in claim1, wherein the first recording layer is a write once layer and the second recording layer is one selected from a write once layer, a rewritable layer and a read only layer.</p> |
| <p>3. A dual stack optical data storage medium as claimed in any one of claims 1 or 2, wherein the first radiation beam entrance face is in a first protective cover layer separate from the first substrate.</p> | <p>1. An optical data storage medium (20) for recording by means of a focused radiation beam (9) entering the medium through a first plastic/resinous layer (1) which is transparent for the radiation beam (9), said medium further comprising at least: a first recording stack (2), comprising a first recording layer, being present proximate the first plastic/resinous layer, a second recording stack (4), comprising a</p> |

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| | <p>second recording layer, said second recording stack (4) being present at a position more remote from the first plastic/resinous layer (1) than the first recording stack (2), a transparent spacer layer (3) between the first and the second recording stack having a thickness larger than the depth of focus of the focused radiation beam characterized in that a first optically transparent thermal barrier layer (b1) interposed between the first recording stack and the first plastic/resinous layer.</p> |
| <p>4. A dual stack optical data storage medium as claimed in any one of claims 1 - 3, wherein the medium further comprises a second radiation beam entrance face opposite from the first radiation beam entrance face and a third layer stack, comprising a third information layer selected from the group consisting of a read only layer and a write once layer, a fourth layer stack, comprising a fourth information layer selected from the group consisting of a read only layer, a write once layer and a rewritable layer, said third layer stack being present at a position closer to the second radiation beam entrance face than the fourth layer stack, a second transparent spacer layer between the third layer stack and the fourth layer stack, and that the type of the third information layer is different from the type of the fourth</p> | <p>8. An optical data storage medium (30) as claimed in any one of claims 1- 7, wherein the medium further comprises at least: a second plastic/resinous layer (1 ') transparent for the radiation beam (9), opposite from the first plastic/resinous layer (1), a third recording stack (2'), comprising a third recording layer, being present proximate the second plastic/resinous layer, a fourth recording stack (4'), comprising a fourth recording layer, said fourth recording stack being present at a position more remote from the second plastic/resinous layer (1 ') than the third recording stack (2'), a transparent spacer layer (3') between the third and the fourth recording stack having a thickness larger than the depth of focus of the focused radiation beam a second optically transparent thermal barrier layer (b2), interposed between the third recording stack and the</p> |

| information layer. | second plastic/resinous layer. |
|---|--|
| <p>5. A dual stack optical data storage medium as claimed in claims 3 and 4, wherein the second radiation beam entrance face is in the first substrate.</p> | <p>8. An optical data storage medium (30) as claimed in any one of claims 1- 7, wherein the medium further comprises at least: a second plastic/resinous layer (1 ') transparent for the radiation beam (9), opposite from the first plastic/resinous layer (1), a third recording stack (2'), comprising a third recording layer, being present proximate the second plastic/resinous layer, a fourth recording stack (4'), comprising a fourth recording layer, said fourth recording stack being present at a position more remote from the second plastic/resinous layer (1 ') than the third recording stack (2'), a transparent spacer layer (3') between the third and the fourth recording stack having a thickness larger than the depth of focus of the focused radiation beam a second optically transparent thermal barrier layer (b2), interposed between the third recording stack and the second plastic/resinous layer.</p> |
| <p>6. A dual stack optical data storage medium as claimed in claims 3 and 4, wherein the second radiation beam entrance face is in a second protective cover layer.</p> | <p>8. An optical data storage medium (30) as claimed in any one of claims 1- 7, wherein the medium further comprises at least: a second plastic/resinous layer (1 ') transparent for the radiation beam (9), opposite from the first plastic/resinous layer (1), a third recording stack (2'), comprising a third recording layer, being present proximate the second plastic/resinous layer, a fourth recording stack (4'),</p> |

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| | comprising a fourth recording layer, said fourth recording stack being present at a position more remote from the second plastic/resinous layer (1') than the third recording stack (2'), a transparent spacer layer (3') between the third and the fourth recording stack having a thickness larger than the depth of focus of the focused radiation beam a second optically transparent thermal barrier layer (b2), interposed between the third recording stack and the second plastic/resinous layer. |
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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. US 2001/0016242 A1 (Miyamoto hereinafter) in view of Kaneko et al. 5,726,970 (Kaneko hereinafter).

Regarding claim 1, Miyamoto teaches a dual stack optical data storage medium (see Fig. 1) for recording and reading by means of a focused radiation beam entering the medium through a first radiation beam entrance face (laser beam onto the recording layer of the optical disc, para [0100]), said medium having at least a first substrate with on at least one side of the first substrate (1-1): a first layer stack (1-2 to 1-9), comprising a first information layer (1-5), a second layer stack (1-2' to 1-9'), comprising a second information layer (1-5'), said first layer stack being present at a position closer to the first radiation beam entrance face than the second layer stack, a first transparent spacer layer between the first layer stack and the second layer stack (1-10), but Miyamoto fails to teach a dual stack storage medium characterized in that the first information layer is one selected from the group of types consisting of a read only layer and a write once layer, and that the second information layer is one selected from the group of types consisting of a read only layer, a write once layer and a rewritable layer, and that the type of the first information layer is different from the type of the second information layer. However, Kaneko teaches a read-only-memory (ROM) type information storage layer having a high light-transmittance is provided on a transparent substrate and a rewritable information storage layer is provided on the ROM layer through a spacer layer (col 2 line 35-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the optical recording medium of Miyamoto to select a read only layer or a write once layer for the first layer and a read only layer, a write once layer or a rewritable layer for the second layer. The modification would have been obvious because the medium would be capable of reproducing signals stored on the respective information storage layers thereof in a sufficient level and treating a large volume of information as taught by Kaneko.

Regarding claim 2, Kaneko teaches a dual stack optical data storage medium as claimed in claim 1, wherein the second information layer is a rewritable layer (col 2 lines 35-45).

Regarding claim 3, Miyamoto teaches a dual stack optical data storage medium as claimed in any one of claims 1 or 2, wherein the first radiation beam entrance face is in a first protective cover layer separate from the first substrate (the laser beam is reflected on the substrate surface, para [0084]).

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto in view of Matz et al. 6,067,312 (Matz hereinafter).

Regarding claim 4, Miyamoto teaches a dual stack optical data storage medium as claimed in any one of claims 1 - 3, but Miyamoto fails to teach a medium wherein the medium further comprises a second radiation beam entrance face opposite from the first radiation beam entrance face and a third layer stack, comprising a third information layer selected from the group consisting of a read only layer and a write once layer, a fourth layer stack, comprising a fourth information layer selected from the group

consisting of a read only layer, a write once layer and a rewritable layer, said third layer stack being present at a position closer to the second radiation beam entrance face than the fourth layer stack, a second transparent spacer layer between the third layer stack and the fourth layer stack, and that the type of the third information layer is different from the type of the fourth information layer. However, Matz teaches four layer stacks (see col 3 lines 19-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dual-stack optical recording medium of Miyamoto to include a third and fourth stack layers. The modification would have been obvious because the medium would be capable of storing more data.

Regarding claim 5, Miyamoto teaches a dual stack optical data storage medium as claimed in claims 3 and 4, wherein the second radiation beam entrance face is in the first substrate (the laser beam is reflected on the substrate surface, para [0084]).

7. Claims 8-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto and further in view of Wisnudel et al. US 2004/0043254A1 (Wisnudel hereinafter).

Re claim 8, Miyamoto teaches a dual stack optical data storage medium as claimed in claim one but he does not mention anything about the effective reflection level of the stacks. However, Wisnudel discloses layer preferably comprising a percent reflectivity of about 45% or less, with about 30% or less preferred, about 20% or less more preferred

(page 6 para [0076]) at a radiation beam wavelength of approximately 655nm (page 2 para [0023]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dual-stack optical recording medium of Miyamoto to include layers with effective reflection level of certain percentage. The modification would have been obvious because it is highly important to control reflectivity in optical storage mediums.

Re claim 9, Miyamoto teaches about a dual stack optical data storage medium as claimed in claim 3 but he does not mention anything about the effective reflection level of the stacks. However, Wisnudel discloses layer preferably comprising a percent reflectivity of about 45% or less, with about 30% or less preferred, about 20% or less more preferred, and about less than 10% especially preferred (page 6 para [0076]) at a radiation beam wavelength of approximately 405nm (page 2 para [0023]).

Re claim 10, Miyamoto teaches about a dual stack optical data storage medium as claimed in claim 3 but he does not mention anything about the effective reflection level of the stacks. However, Wisnudel discloses layer preferably comprising a percent reflectivity of about 45% or less, with about 30% or less preferred, about 20% or less more preferred, at a radiation beam wavelength of approximately 655nm (page 2 para [0023]) and about less than 10% especially preferred (page 6 para [0076]) at a radiation beam wavelength of approximately 405nm (page 2 para [0023]).

Conclusion

The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henok G. Heyi whose telephone number is (571) 270-1816. The examiner can normally be reached on Monday to Friday 8:30 to 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HGH
Patent Examiner
12/06/2007


TAN DINH
PRIMARY EXAMINER

12/10/07